b.) Remarks

In the outstanding Office Action, the Examiner required that Applicants elect for prosecution one of the fifty-eight Groups noted on pages 2-12 of the Office Action.

The groups can be characterized as:

- β1,3-N-acetylglucosaminyltransferase (Groups I-IV);
- polynucleotides encoding β1,3-N-acetylglucosaminyltransferase (Groups V-VIII);
- methods of making β1,3-N-acetylglucosaminyltransferase using a transgenic animal (Groups IX-XII);
- methods of making a sugar using β1,3-N-acetylglucosaminyltransferase (Groups XIII-XVI);
- methods of making a sugar using a transformed cell encoding β1,3-N-acetylglucosaminyltransferase (Groups XVII-XX);
- methods of making a sugar using a transgenic animal producing β1,3-N-acetylglucosaminyltransferase (Groups XXI-XXIV);
- methods of making a sugar using a transgenic plant producing β1,3-N-acetylglucosaminyltransferase (Groups XXV-XXVIII);
- methods of determining expression of a polynucleotide encoding β1,3-N-acetylglucosaminyltransferase by hybridization (Groups XXIX-XXXII);
- methods of determining expression of a polynucleotide encoding β1,3-N-acetylglucosaminyltransferase by PCR (Groups XXXIII-XXXVI);
- antibodies to β1,3-N-acetylglucosaminyltransferase (Groups XXXVII-XL);
- methods for screening modulators of β1,3-N-acetylglucosaminyltransferase (Groups XLI-XLIV);
- methods for screening modulators of expression of β1,3-N-acetylglucosaminyltransferase gene (Groups XLV-XLVIII);

- promoter capable of controlling transcription of a β1,3-N-acetylglucosaminyltransferase gene (Group IL);
- methods of screening for modulators of promoter capable of controlling transcription of a β1,3-N-acetylglucosaminyltransferase gene (Group L):
- modulators of β1,3-N-acetylglucosaminyltransferase (Groups LI-LIV; and
- transgenic animal with a deleted or mutated β1,3-N-acetylglucosaminyltransferase gene (Groups LV-LVIII).

At the outset, while some of these groups are plainly separate inventions (Groups XXXVII-XL for instance) from others, the technical bases for restricting some remaining groups is not clear.

For example, as to Groups XIII-XXVIII, it seems plain that if the method of making a sugar using the noted transferase is patentable, then it is immaterial how that transferase is provided, e.g., whether by cell, animal or plant.

More to the point, however, the Examiner has made no showing that the amino acid sequences among Groups I-IV are separately patentable, or that the nucleotide sequences among Groups V-VIII are separately patentable. Respectfully submitted, MPEP §§803.04 and 2434 makes clear that ten nucleotide sequences will normally be examined together, even when they encode different proteins. Here, there are only four nucleotide sequences, and they all encode β1,3-N-acetylglucosaminyltransferase.

Similarly, even a cursory review of the claims makes clear that many are exceedingly related. For instance, SEQ ID NO:2 differs from SEQ ID NO:3 only at the 328th amino acid.

The foregoing Amendment is submitted in an earnest attempt to reduce all issues and engender an appropriate reformulation of the Restriction Requirement, based in law and in fact. In that connection, in response to the Examiner's requirement, Applicants

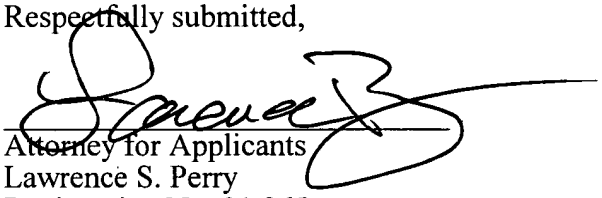
hereby elect to prosecute the invention of Group XIV, namely Claims 31-33 and 38), drawn to methods of making a sugar using β1,3-N-acetylglucosaminyltransferase, with traverse.

Claims 31-39 are presented for continued prosecution, with reformulation of the Restriction Requirement to encompass those claims being respectfully requested.

Entry hereof is earnestly solicited.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,



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